

JAN 16 2007

Application No. 10/785349  
Page 4

Amendment  
Attorney Docket No. S63.2N-9776-US02

### Remarks

This Response After Final and Request for Reconsideration is in response to the Final Office Action dated November 16, 2006. In the Final Office Action, claim 1 was rejected under 35 USC 102(e) as being anticipated by Mikus et al (US. Appln. No. 2002/0035391); claims 2, 6 and 7 were rejected under 35 USC 103(a) as being unpatentable over Mikus et al in view of Boylan et al (US Appln. No. 2003/0187497); claims 4 and 5 were rejected under 35 USC 103(a) as being unpatentable over Mikus et al in view of Guglielmi et al (6,011,995); and claim 8 was rejected under 35 USC 103(a) as being unpatentable over Mikus et al in view of Boylan et al and further in view of Guglielmi et al.

The following comments are presented in the same order, with section headings, as the Final Office Action.

### 35 USC 102

In the Office Action, claim 1 was rejected under 35 USC 102(e) as being anticipated by Mikus et al (US Appln. No. 2002/0035391). In the Final Office Action, Examiner reasserts that the broadest meaning of the term "about" in the dictionary is "reasonably close to" or "in the vicinity." Applicant asserts that the primary resource to use to determine the ordinary and customary meaning of the term "disposed about" is the specification of the instant application (MPEP 2111.01 III). It is the *use of the words in the context of the written description* and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and "customary" meaning of the terms in the claims" (MPEP 2111.01 III, emphasis added). The Federal Circuit also emphasized this approach in *Phillips v. AWH Corp.*, 75

*Application No. 10/785349*  
*Page 5*

*Amendment*  
*Attorney Docket No. S63.2N-9776-US02*

USPQ2d 1321, 1326 (Fed. Cir. 2005), which states that “a person of ordinary skill in the art is deemed to *read the claim term* not only in the context of the particular claim in which the disputed term appears, but *in the context of the entire patent*, including the specification” (emphasis added). If an extrinsic reference source, such as a dictionary, provides more than one definition for the term at issue, “the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms” (MPEP 2111.01 III).

In the present application, the context and use of the term “disposed about” in the claims and specification make the meaning of the phrase both clear and understandable. In instant claim 1 and 6 it is recited that an expandable stent is disposed about at least a portion of the expandable region. As used here the word “about” clearly modifies the word “disposed” to illustrate that the stent is positioned and surrounds at least a portion of the expandable region, that is to say the stent is disposed about at least a portion of the expandable region. Nothing in the claim language would indicate to one of ordinary skill any other meaning of the phrase. Certainly, there is nothing to indicate that the stent is merely near or “relatively close to” the expandable region. Such an interpretation of the phrase “disposed about” would simply ignore the clear meaning of the phrase as well as its context of use.

Though Applicant believes the meaning of the various claim terms is apparent from the usage and context in the claims themselves, additional support for their meaning is found in the specification and figures of the instant application. Applicant refers again to Fig. 4 of the instant application as an example of the meaning of “disposed about.” In Fig. 4, the outer member 106 is “disposed about” the inner member 104 (application, page 4, lines 21-22). Additional references in the specification of the instant application that illustrates Applicant’s use

*Application No. 10/785349*  
*Page 6*

*Amendment*  
*Attorney Docket No. S63.2N-9776-US02*

of "disposed about" are on page 4, lines 18-19 and lines 21-22; page 5, lines 2-4, line 13 and lines 30-32; and page 6, lines 1-2. Rather than referring to elements being near or "reasonably close to", as used in the present application, in every instance, the term "disposed about" refers to the relative position of one tubular element surrounding some portion of another element ... in other words an element is "disposed about" the other. The present application provides for no other interpretation of this phrase. Based on instant application, it is clear that the definition of "about" which is most consistent with applicant's use of the term is "on all sides" or "around," not "reasonably close to" or "in the vicinity," as asserted by the Examiner.

With this definition of "disposed about" in mind, it is clear that Mikus does not teach or suggest all the elements of instant independent claim 1 because, as shown in Figs. 2-7, the stent in Mikus is positioned a distance away from the expandable region, i.e. the mesh basket 14. Therefore, the stent is not "disposed about" the mesh basket 14, as that term is used in the instant application.

The Final Office Action also asserts that paragraph 0025 of Mikus discloses "delivering a stent to a certain location via the use of the stent's expandable region" (Final Office Action, page 5). Mikus however, fails to teach or suggest "delivering the stent to the desired location by expanding the expandable region from an unexpanded diameter to an expanded diameter" as instant claim 1 recites. The expandable region of the Mikus delivery system is the mesh basket 14. As discussed previously and shown in Figs. 2-7 of Mikus, the stent in Mikus is not disposed about the mesh basket 14 but is placed a distance away from the mesh basket 14 so that expansion of the mesh basket does not expand the stent.

For at least these reasons, Mikus does not teach or suggest "each and every element" of the claim as required for a prima facie case of anticipation (MPEP 2131). Applicant

*Application No. 10/785349*  
*Page 7*

*Amendment*  
*Attorney Docket No. S63.2N-9776-US02*

requests withdrawal of the rejection and asserts that independent claim 1 is in condition for allowance.

**35 USC 103**

In the Office action claims 2, 6 and 7 were rejected as being unpatentable over Mikus et al. in view of Boylan et al (2003/0187497). Claim 6 is an independent claim and claims 2 and 7 are dependent claims.

As discussed above, Mikus does not teach or suggest all of the elements of instant independent claims 1 or 6, namely, "a stent ... disposed about at least a portion of an expandable region." The proposed addition of the stent made of steel alloys of Boylan does nothing to address the failure of Mikus to teach or suggest all of the elements of instant claims 2, 6 and 7. Applicant request withdrawal of the rejection and assert that claims 2, 6 and 7 are in condition for allowance.

In the Office Action, claims 4 and 5 were rejected under 35 USC 103(a) as being unpatentable over Mikus et al in view of Guglielmi et al. (6,011,995). Claims 4 and 5 are dependent upon instant independent claim 1. As discussed above, Mikus does not teach or suggest all of the elements of instant independent claim 1. The proposed addition of the contrasting agent of Guglielmi to Mikus does nothing to address the failure of Mikus to teach or suggest all of the elements of instant dependent claims 4 and 5. Applicants request withdrawal of the rejection and assert that dependent claims 4 and 5 are in condition for allowance.

In the Office Action, claim 8 was rejected under 35 USC 103(a) as being unpatentable over Mikus et al in view of Boylan et al and in further view of Guglielmi et al. Claim 8 is dependent upon independent claim 6. The proposed addition of the stent made of

JAN 16 2007

Amendment

Application No. 10/785349  
Page 8

Attorney Docket No. S63.2N-9776-US02

steel alloys of Boylan and the contrasting agent of Guglielmi does nothing to address the failure of Mikus to teach or suggest all the elements of independent claim 6. Applicants request withdrawal of the rejection and assert that dependent claim 8 is in condition for allowance.

### Conclusion

Based on at least the above, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-2 and 4-8 is requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT &amp; STEINKRAUS

Date: January 16, 2007By: Jennifer L. Buss

Jennifer L. Buss

Registration No.: 57321

6109 Blue Circle Drive, Suite 2000  
Minnetonka, MN 55343-9185  
Telephone: (952) 563-3000  
Facsimile: (952) 563-3001

f:\pwork\jlb\09776us02\_and\_20061128.doc